

**REMARKS**

Claims 1-8 are pending in this application after this Amendment; claims 7 and 8 being independent. In light of the remarks made herein, it is respectfully requested that the outstanding rejections be reconsidered and withdrawn.

**Official Action**

In the Office Action dated April 29, 2002, it is unclear under which section of 35 U.S.C. § 102 the Examiner is rejecting claims 7, 1, and 2. The Examiner cites to section (e) of the Code in paragraph 2 of Paper 3; however, in paragraph 3 of Paper 3, the Examiner rejects the claims under section (b) as being anticipated by *Eda et al.* (USP 6,044,723). Applicants will assume the Examiner has rejected the claims under section (e). The *Eda et al.* reference does not qualify as prior art under section (b) as the patent date of April 4, 2000 is not more than one year prior to the filing date of the present application, namely September 6, 2000. The Examiner further rejected claims 7 and 1-4 under 35 U.S.C. § 103(a) as being unpatentable over *Bisiach* (USP 4,827,790) in view of *Eda et al.*.

**Claim Rejections - 35 U.S.C. § 102**

With regard to the Examiner's rejection of claims 7, 1, and 2 under 35 U.S.C. § 102(e) as being anticipated by *Eda et al.*, Applicants respectfully traverse these rejections.

Applicants respectfully submit the Examiner has the burden of pointing out the portions of each reference the Examiner has relied upon. "When the reference is complex or shows or describes inventions other than that claimed by the Applicant, the

particular part relied on must be designated as nearly as practicable." See 37 C.F.R. § 1.104(c)(2).

Applicants note the Office Action lacks specific cites within the *Eda et al.* reference supporting the alleged disclosure for the 35 U.S.C. § 102 claim rejections. Applicants must therefore assume the portions of these references the Examiner is relying upon for the basis of these rejections. If the Examiner maintains the 35 U.S.C. § 102 rejections based on the *Eda et al.* reference, Applicants respectfully request the Examiner provide a full and complete explanation of these rejections in a non-final Office Action so Applicants may have adequate opportunity to properly respond to the rejections.

It is respectfully submitted that *Eda et al.* teaches an electric power assisting steering apparatus. Specifically, *Eda et al.* teaches

[T]he vicinity of the left end of the rotating shaft 130 is supported by the two bearings 8a, 8b which are disposed in series. The bearings 8a, 8b are mounted to be incapable of moving in the axial direction relative to the housing 1 by the stop ring 9. A flange portion 130c is formed to the right side of the bearings 8a, 8b, while an outer peripheral groove 130e is formed to the left side thereof. (Col. 6, lines 53-60).

In contrast, the present invention as set forth in claim 7 recites, *inter alia*, an electric power steering apparatus comprising a biasing member biasing one of the worm shaft and the worm wheel toward the other one of the worm shaft and the worm wheel. It is respectfully submitted that *Eda et al.* teaches bearings 8a and 8b being mounted to be incapable of moving in the axial direction relative to the housing 1 by the stop ring 9. *Eda et al.* fails to teach a biasing member biasing one of the worm shaft and the worm

wheel toward the other of the worm shaft and the worm wheel. As such, claim 7 is not anticipated by *Eda et al.* and is thus allowable.

It is respectfully submitted that claims 1-4 are allowable for the reasons set forth above with regard to claim 7 based upon their dependency on claim 7.

**Claim Rejections - 35 U.S.C. § 103**

With regard to the Examiner's rejection of claims 7 and 1-4 under 35 U.S.C. § 103(a) as being unpatentable over *Bisiach* in view of *Eda et al.*, Applicants respectfully traverse these rejections.

The Examiner asserts *Bisiach* discloses biasing member 55 to bias the worm shaft toward the worm wheel in a deflective direction of the worm shaft.

It is respectfully submitted that *Bisiach* teaches a system for the automatic recovery of play between a worm and a worm gear. Specifically, *Bisiach* teaches a pushing device 55 acting on the movable assembly 28. (Col. 3, lines 2-3). The rotation of the pulse motor 54 is transmitted through the chain 52 and the pinion 50 to the worm 18 which by meshing with the worm gear 16 generates a thrust in a direction perpendicularly to the axis of rotation of the worm so as to shift the movable assembly 28 and the flat tab 72, connected thereto, toward the lower end of the flanged sleeve 58, thus overcoming the force exerted by the flat-headed pin 62 which is pushed by the cup springs 66 thereagainst. (Col. 3, lines 27-35).

In contrast, the present invention as set forth in claim 7 recites, *inter alia*, an electric power steering apparatus comprising a biasing member biasing one of the worm shaft and the worm wheel toward the other of the worm shaft and the worm wheel. It is respectfully submitted that *Bisiach* teaches pushing member 55 acting on moving

assembly 28, and not on the worm wheel or the worm shaft. It is further respectfully submitted that *Eda et al.* fails to cure the deficiencies of the teachings of *Bisiach* as *Eda et al.* fails to teach a biasing member. As such, neither *Bisiach* nor *Eda et al.*, nor the combination of the references, assuming the references are combinable, which Applicants do not admit, teach the biasing member of the present invention, and thus claim 7 is allowable.

It is respectfully submitted that claims 1-4 are allowable for the reasons set forth above with regard to claim 7 based upon their dependency on claim 7.

By this Amendment, Applicants have added new claim 8 reciting, *inter alia*, a biasing member biasing, via a bearing, one of the worm shaft and the worm wheel toward the other of the worm shaft and the worm wheel. It is respectfully submitted that neither *Bisiach*, *Eda et al.*, nor the combination thereof teach a biasing member biasing, via a bearing, one of the worm shaft and the worm wheel toward the other of the worm shaft and the worm wheel.

#### **Additional Remarks**

On September 6, 2000, Applicants filed an Information Disclosure Statement. To date, Applicants have not received a signed copy of Form PTO-1449. Applicants respectfully request consideration of the document contained in the Information Disclosure Statement.

#### **CONCLUSION**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet

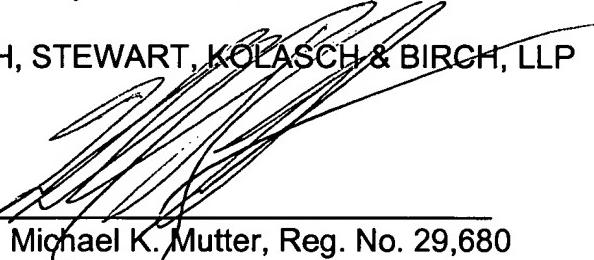
(Provisional Reg. No. 52,327) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner of hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:

  
Michael K. Mutter, Reg. No. 29,680

MKM/CMV/jdm  
1560-0348P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

Attachment: Version With Markings to Show Changes Made

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

New claim 8 has been added.